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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,768	02/18/2004	Shinichi Itoh	009270-0308308	1603

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EXAMINER

JOERGER, KAITLIN S

ART UNIT PAPER NUMBER

3653

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/779,768	<b>Applicant(s)</b> ITOH ET AL.	
	<b>Examiner</b> Kaitlin S. Joerger	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/22/06.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/18/04 6/28/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 4-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 5/22/06.

Applicant's election with traverse of claim 1-3 in the reply filed on 22 May 2006 is acknowledged. The traversal is on the ground(s) that no serious burden to search and examine the entire application exists. This is not found persuasive because there is a serious burden. The claims contain claims to a roller, a stamping apparatus, a conveying apparatus, and a switching apparatus. A different search is required for each of the different claimed apparatuses.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al. in view of Kawasaki et al.

Nishida et al. teaches a paper-like material conveying apparatus comprising:

- a drive roller, 12, which is given a driving force, rotated and driven; and

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- a driven roller, 20, rotatably following the rotation of the drive roller, the driven roller including a first layer, 23, formed with a solid elastic material, that is in contact with the drive roller and a second layer, 24, formed with a foam elastic material inside the first layer,
- wherein paper-like materials conveyed into the nip between the drive roller and the driven roller are punched, conveyed and carried out and a thickness of the first layer is below  $\frac{1}{2}$  of that of the second layer, see figure 3A, a compression of the second layer is below 5%, see column 2, lines 59+, and a thickness of the second layer is more than 1.8 times of the most thick paper-like material.

Nishida et al. teaches all of the features of the claimed invention except for a coefficient between the first layer and the paper-like materials is more than .7 and a hardness of the second layer that is below 40, but Kawasaki et al. does teach these features.

Kawasaki et al. teaches a paper-like conveying roller with a first layer, 4, and a second layer 3. The dynamic coefficient of friction of the first layer is .25 or more, and more preferably 3.0 or more, see column 5, lines 1+ for the purpose of successfully providing high quality images free from image failure and improved durability of the roller, see column 2, lines 50+. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an elastic layer with a high coefficient of friction, of more than 3, as taught by Kawasaki et al. for the purpose of conveying paper with high quality images and without image failure through a printing machine.

Kawasaki et al. further teaches a hardness of the second layer, 3, that is below 40, Table 1 shows a hardness of the second layer 4 of 10. It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to use a material for the second layer with a hardness below 40, as taught by Kawasaki et al. for the purpose of providing a relatively softer inner layer that was more compressible, and therefore would more stable convey the paper-like material.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al. in view of Kawasaki et al. as applied to claim 1 above, and further in view of Tucker et al.

The combination of Nishida et al. and Kawasaki et al. teach all of the features of the claimed invention except for a tear strength value of the second layer that is above 6 kN/m. Tucker et al. teaches flexible polyurethane foams that are used in many fields and that have a tear strength of above 6kN/m, see example 1, 2, and 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a foam with a tear strength of 6 kN/m or greater for the purpose of have using a foam with strong physical properties that is resistant to damage and is more durable.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S. Joerger whose telephone number is 571-272-6938. The examiner can normally be reached on Monday - Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ksj

31 July 2006



**PATRICK MACKEY**  
**PRIMARY EXAMINER**